

Appl. No.: 10/089,010
Amdt. dated March 30, 2005
Reply to Office action of January 10, 2005

REMARKS

The Official Action objected to the drawing under 37 CFR § 1.84(p)(5) for failing to include reference signs S210, S222, S224 and S238. Based upon a further review of the specification and the drawings, the specification has been amended to delete reference to step S210 as well as corresponding step S110 since neither step was described or illustrated by the present application. Additionally, the specification has been amended to delete reference to steps S222 and S224. Based upon the deletion of reference to steps S222 and S224, the specification has also been amended to appropriately correlate steps depicted in Figure 5 with comparable steps depicted in Figure 6. With respect to the objection regarding step S238, Replacement Sheet 6/6 is submitted herewith which correctly depicts both steps S236 and S238 in accordance with the description of comparable steps S136 and S138 of Figure 4. Similarly, Replacement Sheet 5/6 is submitted herewith to amend Figure 5 in order to more properly represent steps S136 and S138 in the manner set forth by those same steps in Figure 4.

As the amendments to the specification and to Figures. 5 and 6 were described by the patent application as originally filed, these amendments do not introduce new matter. However, the amendments to the specification and Replacement Sheets 5/6 and 6/6 address each of the issues raised by the Official Action in the objection to the drawings. As such, Applicants respectfully submit that the objection to the drawings is therefore overcome.

The Official Action rejected Claims 1, 2, 3, and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,714,799 to Jeon-Man Park, et al. The Official Action also rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over the Park '799 patent in view of U.S. Patent No., 6,438,117 to Francesco Grilli et al. Finally, the Official Action rejected Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the Park '799 patent in view of a published Korean application bearing Publication No. KR 2002021542 A to Y.S. Shin. Independent Claim 1 has been amended in order to further patentably distinguish the claimed invention from the cited references, taken either individually or in combination. In addition, Claim 6 has been amended to now depend from Claim 5. Moreover, new Claims 7-12 have been added in order to define still other unique aspects of the present invention. Based on the

Appl. No.: 10/089,010
Amdt. dated March 30, 2005
Reply to Office action of January 10, 2005

Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 5 and 6 and replace the original sheets that included Figures 5 and 6. Figure 5 has been amended to more properly reference steps S136 and S138, while Figure 6 has been amended to more properly represent steps S236 and S238.

Attachment: Replacement Sheets 5/6 and 6/6

Appl. No.: 10/089,010
Amdt. dated March 30, 2005
Reply to Office action of January 10, 2005

foregoing amendments and the following remarks, Applicants respectfully request reconsideration of the present application and allowance of the current set of claims.

The present application now includes three independent claims, namely, independent Claims 1, 5 and 8. Each of these independent claims will be separately discussed below.

1. Independent Claim 1

Independent Claim 1 recites a CDMA terminal having a subscriber identity module (SIM) cardholder in which a SIM card of a GSM subscriber may be installed or uninstalled. As recited by independent Claim 1, in instances in which a SIM card of a GSM subscriber is installed in the SIM cardholder while the CDMA terminal is in a CDMA service area, data is transmitted to authenticate the GSM subscriber using information regarding the GSM subscriber that is stored by the SIM card. Independent Claim 1 further recites that upon completion of authentication of the GSM subscriber, the CDMA terminal is used by the GSM subscriber as a roaming service terminal in the CDMA service area. Thus, a GSM subscriber can utilize a CDMA terminal while in a CDMA service area without having to reenter or otherwise again provide the information stored on the SIM card of the GSM subscriber by installing the SIM card in a SIM cardholder of the CDMA terminal and awaiting authentication of the GSM subscriber by the CDMA terminal.

The Park '799 patent also describes a system for allowing a GSM subscriber to use a SIM card in a CDMA service area. A CDMA terminal includes a SIM interface for receiving a SIM card and for permitting a controller of a CDMA terminal to communicate with the SIM card. The CDMA terminal reads unique subscriber information from the SIM card and forwards the unique subscriber information to a GSM system via a public network for verification. Once verified, the GSM subscriber can utilize a CDMA terminal equipped with the subscriber's SIM card while in a CDMA service area.

As now amended, independent Claim 1 further defines the CDMA terminal to be configured to transmit data from the SIM card for purposes of authenticating the GSM subscriber utilizing a CDMA data burst message. The transmission of the data utilizing CDMA data burst

messages is advantageous as described by the present application on page 13, lines 7-16 as follows:

One of the additional functions is to use CDMA data burst messages so as to deliver data to the GSM system 2000 that is needed for user authentication when registering the location of a roaming subscriber. By transmitting the messages through the CDMA data burst channel, modification of the present network is minimized and more roaming subscribers can be accommodated.

The message transmission through the CDMA data burst channel is used for transmitting short messages, and the CDMA data burst messages can use all CDMA wireless channels, any of which can transmit and receive data without modifying the network.

The Park '799 patent describes information from the SIM card being transmitted for authentication purposes in a data format as described in column 6, lines 40-45 and as shown in Figure 8, but does not teach or suggest transmitting the data from the SIM card for purposes of authentication using a CDMA data burst message, as now recited by amended independent Claim 1. Accordingly, Applicants submit that the Park '799 patent does not teach or suggest the CDMA terminal of amended independent Claim 1. Further, none of the other cited references teach or suggest transmitting data from a SIM card of a CDMA terminal for purposes of authenticating a GSM subscriber utilizing a CDMA data burst message as recited by amended independent Claim 1. Thus, Applicants respectfully submit that the rejection of amended independent Claim 1, as well as Claims 2-4 which depend therefrom, is therefore overcome.

2. Independent Claim 5

Independent Claim 5 is directed to a CDMA terminal including a cardholder in which a user identity module (UIM) of a CDMA subscriber may be installed and uninstalled. The CDMA terminal of independent Claim 5 also includes a card interface for detecting whether a UIM card is installed in a cardholder and, in instances in which the card interface detects that the UIM card is installed in the cardholder while the CDMA terminal is in the CDMA service area, the CDMA subscriber is permitted access to the CDMA service. Additionally, the cardholder of

the CDMA terminal of independent Claim 5 is configured such that a SIM card of a GSM subscriber may be installed or uninstalled and the card interface can similarly detect whether the SIM card is installed in the cardholder. In instances in which the card interface detects that the SIM card of a GSM subscriber is installed in the cardholder while the CDMA terminal is in the CDMA service area, the CDMA terminal is configured to transmit data to authenticate the GSM subscriber utilizing information relating to the GSM subscriber stored by the SIM card. Once the authentication of the GSM subscriber is completed, the CDMA terminal is operable as a roaming terminal for the GSM subscriber in the CDMA service area. Thus, the CDMA terminal of this embodiment includes a multi-purpose cardholder than can receive either a UIM card of a CDMA subscriber or a SIM card of a GSM subscriber.

In rejecting independent Claim 5 as being obvious, the Official Action in paragraph 5 noted that the Park '799 patent "does not expressly disclose a cardholder for installing and uninstalling a user identity module (UIM) of a CDMA service subscriber; and a card interface for detecting whether a UIM card is installed in the cardholder, wherein when the card interface detects the UIM card of the CDMA service subscriber is installed in the cardholder in the CDMA service area, the CDMA service subscriber can use the CDMA service." As such, the Official Action cites the Shin '542 application for its disclosure of a removable-user identity module (R-UIM) of a CDMA terminal that may be changed as the subscriber moves from one country to another, all of which have CDMA systems. The Official Action continues by determining that "it would have been obvious to improve upon Park et als' CDMA terminal with SIM card in a CDMA service area so that it is interchangeable with Shin Y.S.s' R-UIM card in a CDMA terminal because it would allow CDMA subscribers along with GSM subscribers to use their mobile terminals in a CDMA service area."

Notwithstanding the foregoing rationale provided by the Official Action, Applicants submit that one skilled in the art could not have been motivated to combine the Park '799 patent and the Shin '542 publication in the manner set forth by the Official Action. In this regard, Applicants respectfully submit that it is only through the teaching provided in Applicants' own disclosure that such motivation could be identified. Repeatedly, the Court of Appeals for the Federal Circuit has reiterated the importance of closely adhering to the "critical step of casting

the mind backed in the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.” *In re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In reversing the Board’s obviousness rejections of a relatively simple invention, the Federal Circuit has stated: “close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only an inventor taught is used against its teacher.’” *Id.* (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

In this instance, the Park ‘799 patent describes a CDMA terminal having a SIM interface for receiving a SIM card for permitting a GSM subscriber to use a CDMA terminal equipped with a SIM card in a CDMA service area. However, the Park ‘799 patent does not even mention any desirability for permitting the same interface, denoted a SIM interface, to receive other modules or chips, such as those necessary to permit a CDMA subscriber to utilize the CDMA terminal within the CDMA service area. Thus, the Park ‘799 patent does not provide any motivation or suggestion to provide an interface, such as a cardholder of independent Claim 5, for receiving different types of cards, such as a SIM card and a UIM card, to permit both GSM subscribers and CDMA subscribers to utilize the same CDMA terminal in a CDMA service area. Moreover, the secondary reference only describes swapping out different R-UIM chips as a CDMA subscriber moves from country to country within a CDMA network and does not teach or suggest that the CDMA terminal should be equipped to receive different types of modules or chips that would permit subscribers of different types of networks, such as GSM and CDMA networks, to utilize the same CDMA terminal in a CDMA service area. Accordingly, Applicants submit that it appears only through consideration of the present application that motivation for the combination of the Park ‘799 and the Shin ‘542 application become apparent and that such combination therefore is improper.

Moreover, even if the references were combined, albeit improperly in Applicants’ opinion as described above, Applicants submit that the combination of the references does not teach or suggest a CDMA terminal of independent Claim 5. In this regard, the combination of

Appl. No.: 10/089,010
Amdt. dated March 30, 2005
Reply to Office action of January 10, 2005

the cited references do not teach or suggest a CDMA terminal having a single cardholder and card interface for receiving and detecting both UIM cards and SIM cards as recited by independent Claim 5. Instead, Applicants submit that the combination of the Park '799 patent and the Shin '542 application would result in a CDMA terminal having two different interfaces, one for receiving a SIM card and another for receiving a R-UIM card, since neither reference teaches or suggest that such functions could be provided by the same cardholder and card interface. For each of the foregoing reasons, Applicants submit that the rejection of independent Claim 5, and well as Claim 6 which now depends therefrom, is overcome.

3. New Claims

In order to more fully set forth other unique aspects of the present invention, Claims 7-12 have been added including new independent Claim 8. As none of these newly presented claims are taught or suggest by the cited references, taken either individually or in combination, Applicants submit that new Claims 7-12 are in condition for immediate allowance.

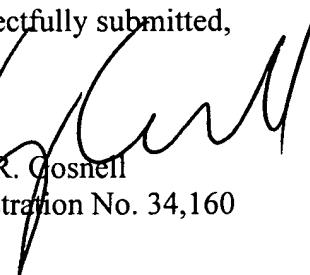
Appl. No.: 10/089,010
Amdt. dated March 30, 2005
Reply to Office action of January 10, 2005

Conclusion

In view of the amended and newly added claims, the amended specification, the amendments to Figures 5 and 6 and the remarks presented above, it is respectfully submitted that all of the claims in the present application are in condition for immediate allowance. It is therefore requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

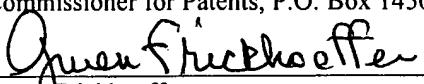
Respectfully submitted,


Guy R. Cosnell
Registration No. 34,160

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 11, 2005.



Gwen Frickhoeffer